

### **REMARKS**

This responds to the Office Action dated November 17, 2006, and the references cited therewith.

No claims are amended. Claims 64-66 are added; as a result, claims 10-12 and 53-66 are now pending in this application.

#### **Election/Restriction**

In the Office Action, the Examiner withdrew newly submitted claims 53-56 and 58-63, as being non-elected. Applicant traverses. The newly submitted claims are dependent claims from claim 10 and Applicant believes that at least some of the newly submitted claims do not have two-way distinction with the previously elected claims. Applicant believes the Office Action has not shown, as required by MPEP 806.05(j), that for each of the newly submitted claims:

- (A) the inventions as claimed do not overlap in scope, i.e., are mutually exclusive;
- (B) the inventions as claimed are not obvious variants; and
- (C) the inventions as claimed are either not capable of use together or can have a materially different design, mode of operation, function, or effect. See MPEP § 802.01.

Accordingly, Applicant requests reconsideration and withdrawal or modification of the withdrawal of at least some of claims 53-56 and 58-63 and substantive examination of the claims.

#### **Objection to the Drawings**

The drawings were objected to as failing to comply with 37 C.F.R. 1.84(p)(5) because reference sign 216 is missing. Applicant submits an informal replacement sheet for FIG. 2 enclosed herewith showing sign 216.

*§102 Rejection of the Claims*

Claims 10 and 12 were rejected under 35 U.S.C. § 102(b) as being anticipated by Tsubota (U.S. Patent No. 5,361,660).

Applicant traverses. Applicant believes claim 11 is not anticipated by the cited reference since: “[a]nticipation requires the presence in a single prior reference disclosure of each and every element of the claimed invention, arranged as in the claim.” *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984).

In this case, Applicant cannot find in the cited reference: delivering a lubricant to a periphery of the die hole, wherein the lubricant is concentrated to a pre-determined location on the periphery, as recited in claim 10. In contrast, the reference discusses that “[t]he cutting oil from the oil supply source 23 is mixed with air and is fed in an atomized state in the form of upward intermittent spurts from the pressurized air supply source to the interior of the cylindrical tool die 11, such that it sticks to the lower tool 7.” Thus, the reference discusses blowing atomized oil to cover the interior of the die. The atomized oil apparently covers the interior of the die relatively equally. This is not the same as “wherein the lubricant is concentrated to a pre-determined location on the periphery,” as recited in claim 10.

Claim 12 includes each limitation of its parent claim and is therefore also not anticipated by the cited reference. Moreover, the reference does not include “the lubricant being concentrated on the periphery of the die hole at the location where the punch cuts through the aluminum portion,” as recited in claim 12. Reconsideration and allowance is respectfully requested.

*§103 Rejection of the Claims*

Claim 11 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Tsubota (U.S. Patent No. 5,361,660) in view of Clint et al. (U.S. Patent No. 3,288,715).

Claim 11 includes each limitation of its parent claim and is not obvious in view of the cited references since the secondary reference does not overcome the deficiencies of the primary reference discussed above. Reconsideration and allowance is respectfully requested.

Claim 57 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Tsubota (U.S. Patent No. 5,361,660) in view of Clint et al. (U.S. Patent No. 3,288,715) and further in view of 3M.

Claim 57 includes each limitation of its parent claim and is not obvious in view of the cited references since the secondary reference does not overcome the deficiencies of the primary reference discussed above. Reconsideration and allowance is respectfully requested.

**CONCLUSION**

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at (612) 359-3267 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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By their Representatives,

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Date 2/19/07

By \_\_\_\_\_

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**CERTIFICATE UNDER 37 CFR 1.8:** The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Mail Stop Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 19 day of February 2007.

Name Paul Scully

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